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IN THE

Supreme Court of the United States

JERRY GREENBERG,

Petitioner,

v.

NATIONAL GEOGRAPHIC SOCIETY, *ET AL.*,

Respondents.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Eleventh Circuit

REPLY BRIEF FOR PETITIONER

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REPLY BRIEF FOR PETITIONER

Rather than address the merits of the questions presented, Respondents focus on the "harmony" that they perceive between the Eleventh Circuit and "a unanimous Second Circuit." They neglect to mention that the *en banc* decision was divided 7-5 with rigorous dissents spanning almost 30 pages of the Federal Reporter. In fact, the word "dissent" does not even appear in their brief in opposition. And Respondents' "unanimous" Second Circuit was a panel that devoted little more than two paragraphs to the question framed by this Petition. They ignore the many scholarly rejections of the majority's approach, the most recent describing it as "a stunning act of judicial ju-jitsu." Neil Boorstyn, *Greenberg v. National Geographic Soc'y*, 22 COPYRIGHT L.J. 50, 54 (Sept.-Oct. 2008). Respondents happily announce that publishers won the war over republication rights, unconcerned about congressional intent.

Respondents unabashedly maintain that the *en banc* majority held that *New York Times Co. v. Tasini*, 533 U.S. 483 (2001), made "context" the acid test for what constitutes a privileged revision under Section 201(c). They applaud the *en banc* court's holding that the context test can be satisfied merely by allowing a user to flip between pages. Publishers thus can, using that technological maneuver, sell (or place online for free) any database of collective works, or any individual contribution to a collective work, without paying the artist. Nor do Respondents disagree that the other factors *Tasini* used to define "revision" – purpose, use, content, and the effect on the market for the artist's contribution – have become

legally irrelevant under the Eleventh Circuit majority's decision.

This begs the question of whether *Tasini* actually intended that the "Congressionally-ordained balance" be tipped so decisively toward publishers by means of so simple an artifice. *Tasini*, of course, held that the purpose of Section 201(c) was to allow freelancers to benefit from any "demand for a freelance article standing alone or in a new collection," *Tasini*, 533 U.S. at 497. It also held that a group of collective works bundled together is a "new collective work" or a "new compendium," not a revision of a particular collective work. *Id.* at 497, 500. As to context, *Tasini* asked if there was "context provided either by the original periodical editions or by any revision of those editions." *Id.* at 499. A contribution had to be seen in context before it could be considered "part of" a revision. *Id.* The *en banc* majority jettisoned those straightforward holdings, creating instead a rule that allowed National Geographic's for-profit subsidiaries to sell over 1.4 million copies of a new collection including Mr. Greenberg's photographs without paying him (or any other contributor) anything.

The questions presented in this Petition are vital to tens of thousands of writers, photographers, and other artists who rely upon a residual income stream from contributions originally published in magazines, newspapers, and other periodicals, including those on the web. They also affect all others who submit content to online venues, but wish to retain control of the future commercial use or exploitation of their work. A final and proper resolution of this issue would provide publishers and freelancers with clear default rules (that *Tasini* sought to clarify), thus

enabling them to negotiate a fair system for compensation and paving the way for the release of archives of every kind to the public as originally contemplated by *Tasini*. *Id.* at 505.

This Court should grant certiorari to clarify (1) that that the definition of revision under Section 201(c) should not be limited to context alone, and (2) that under any reasonable definition of revision, a vast database of unrevised collective works is not a "revision" of each constituent collective work. Accepting certiorari is the only means by which this Court can undo the violence wrought on *Tasini* by the Eleventh Circuit majority.

A. The *En Banc* Court's Decision Conflicts With *Tasini*

Tasini's interpretation of Section 201(c) is premised on two main holdings. First, it held that the term "revision" is limited to *revisions* of the original collective work. *Tasini*, 533 U.S. at 499. Thus, a publisher could print "an article from a 1980 edition of an encyclopedia in a 1990 revision of it" but could not "include it in a new anthology or an entirely different magazine or other collective work." *Id.* at 497, citing H. Rep. 94-1476 (1976), at 122-123, *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5737 ("H. Rep."). New collections do not fall under the Section 201(c) privilege: "the Copyright Act allows the freelancer to benefit from" the demand for "a new collection." *Id.* at 497-98. The original collective work may be reprinted or revised (and must be, to be a *revision*), but cannot become part of a new collective work. *Id.* The plain meaning of the word "revision" required this Court to ask whether a product claiming to be a revision is "recognizable as a new

version" of the original collective work. *Id.* at 499-500.

Tasini also instructed that any definition of revision must take into account the congressional intention to protect the artists' exclusive right to exploit the secondary market: "The Publishers' encompassing construction of the § 201(c) privilege is unacceptable, we conclude, for it would diminish the Authors' exclusive rights in the Articles." *Id.* at 499. *Tasini* repeatedly rejected any interpretations of "revision" that allowed publishers to use a contribution in "*new collective works*" because it would not "'preserve the author's copyright in a contribution' as contemplated by Congress." *Id.* at 497, citing H. Rep. at 122 (emphasis added).

The CNG is a new collection of more than 1200 unrevised collective works that undisputedly "diminished" Mr. Greenberg's exclusive right in the secondary market for his contributions. The CNG thus cannot be privileged under Section 201(c). If it were not clear enough already, *Tasini* explained in a footnote that, regarding improper compilations of collective works, courts of other nations "*have also concluded that Internet or CD-ROM reproduction and distribution of freelancers' works violate the copyrights of freelancers.*" *Tasini*, 533 U.S. at 506 n.13 (emphasis added).

The *en banc* majority repudiated *Tasini*'s two core holdings and its many explanations regarding new collections. Though the majority admitted that the CNG might be a "new collective work," it was privileged because it was not an "entirely different" collective work. (Pet. App. at 17a). It is hard to imagine how a compilation of 1200 collective works,

which compilation never existed before, is not *entirely different* from anything else. Thus, the majority "followed the sloppy reasoning of *Faulkner*" and completely reversed the intended effect of Section 201(c). Boorstyn, 22 COPYRIGHT L.J. at 54.

Respondents do not mention these holdings or respond to Mr. Greenberg's discussion of them in the Petition. They only review this Court's analysis of the context of the contribution within the claimed revision.[1] Yet turning a blind eye to the decision (and dissent) below does not achieve "harmony" with

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[1]Seeking to cloak their position with the imprimatur of the Government, Respondents repeatedly claim, without citation to the record, that the Register of Copyrights has "stated publicly that National Geographic's CNG was a privileged reproduction under § 201(c)." (Br. in Opp. 1, 10 n.4). The reason for the lack of citation is that the statements they apparently refer to were made *before* this Court decided *Tasini*, and the "source" in the record is Terrence Adamson's (Executive Vice-President of National Geographic) recollection that an unnamed source told him that the Register had twice stated that *Greenberg I* was "wrongly decided." Notice of Filing of Decl. of Terrence B. Adamson, Ex. A at ¶12, Dkt #172 at 10, *Greenberg v. Nat'l Geographic Soc'y*, 1:97-cv-03924-AMS (S.D. Fla.). The non-hearsay statements from the Register regarding *Tasini* in the record reaffirm that the purpose of Section 201(c) is "to limit a publisher's exploitation of freelance authors' works to ensure that authors retained control over subsequent commercial exploitation of their works." 147 Cong. Rec. E182-02 (2001) (Letter from Marybeth Peters to Rep. James P. McGovern, U.S. House of Rep. (Feb. 14, 2001)). The dissent below quotes extensively from her statements. (*See* Pet. App. 27a-28a, 67a-70a).

Tasini. In fact, Respondents' unwillingness to respond to the dissenting opinions speaks volumes. The context of an individual contribution is only a necessary threshold question; it does not speak to whether the collective work itself (to which Section 201(c) applies) has been revised.

Unlike the majority, *Tasini* never said that context was a defining factor. Instead, it referred only to "context provided either by the original periodical editions or by any revision of those editions." *Tasini*, 533 U.S. at 499. The article had to be seen in context *before it could be determined* to be part of an original, revision, or a new collective work. *Id.* Context was vital to *Tasini* because the databases disassembled the periodicals, presenting the user with only individual articles. Alone, the articles were not part of a new collective work, a revision, or anything else. Without meeting the context threshold, the article could not be part of either "the original periodical editions" or "any revision of those editions."

But after the threshold, the statutory test must be met. Section 201(c) only privileges contributions that are sold "*as part of* that collective work or any revision of that collective work" (emphasis added). It cannot be sold "as part of" a new or different collective work. As this Court explained, the contribution must be distributed "'as part of' either the original edition or a 'revision' of that edition." *Id.* at 500. Thus, once the threshold is met, the statutory language and *Tasini* ask whether the contribution is sold as part of a revision of the original magazine. Yet Respondents never address that key question: whether Mr. Greenberg's contributions were sold as a

part of a new compilation of collective works or as part of a revision of the original magazine.[2]

Instead of addressing the statute, Respondents focus myopically on the similarities between the context of a contribution provided to a user by the CNG and microfilm. Like the *en banc* majority, they find the comparison between the CNG and microfilm to be the pivotal inquiry under *Tasini*, which renders all other considerations irrelevant. (Br. in Opp. at 14 ("the CNG is simply a digital form of the microform example this Court extolled in *Tasini*")). This is slightly ironic, given that *Tasini* never actually held that microfilm is privileged under Section 201(c). *Tasini* did no more than reject, in dicta, the publisher's comparison between the databases and microfilm.

National Geographic's invocation of the microfilm comparison as its panacea is also curious in light of its earlier statement that microform is inherently non-commercial (*see* Pet. at 28), and thus cannot trigger any of the worries that it will harm the secondary market. After all, from a consumer's perspective, microform is no more desirable than old copies of the magazine gathering dust on a library shelf. It is not instantly searchable and cannot normally be accessed at home or work. A person cannot, with a few clicks of the mouse, save or email

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[2]National Geographic's copyright registration plainly states that the CNG is a *new* compilation from multiple pre-existing works. (Pet. App. 116a-117a).

a picture from microfilm. And, more importantly, publishers of microfilm do not need any privilege from Section 201(c). The libraries and archivists that Respondents mention so many times are protected under the doctrine of fair use, 17 U.S.C. § 107, and by the library-specific provisions of Section 108 that explicitly allow archives of periodicals on microfilm without any infringement. Tellingly, Respondents cite no lawsuits challenging the use of microfilm for periodical archives under copyright law.

Finally, Respondents assail Mr. Greenberg for never mentioning the two petitions for certiorari "on the very issue presented here" from *Faulkner v. Nat'l Geographic Enters.*, 409 F.3d 26 (2d Cir. 2005), and *Greenberg I* (Pet. App. 121a). (*See* Br. in Opp. at 9). Far from just mentioning the petition in *Faulkner*, Mr. Greenberg's Petition actually *quotes* at length from National Geographic's own brief filed *in support of review* of the Section 201(c) question in that case. (*See* Pet. at 29). But, in any case, those two petitions have no bearing on the present one. *Faulkner* devoted little space to the issue, which was only one of many issues in that panel's decision. And this Court denied National Geographic's petition from *Greenberg I* just three months after deciding *Tasini*.[3] As *Greenberg I* was fully consistent with *Tasini*, there was little need to accept the petition. Neither opinion contained anything like the *en banc* court's sweeping

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[3] *Greenberg I* was, of course, overruled by the *en banc* decision below, which reached the opposite result.

pronouncements on (and repudiation of) the boundaries of *Tasini*. Neither court had purported to create a simple legal test, as the *en banc* court did below, that would allow publishers to avoid paying any royalty on new collections. The *en banc* majority's split with *Tasini* is manifest and warrants this Court's immediate review.

B. The *En Banc* Decision Destroys Congressionally-Mandated Rights

As explained in the Petition, the *en banc* decision will significantly harm the ability of freelancers to exploit the secondary market for her works. Granting publishers free reign to sell new compilations of collective works, to display those works for free on the web, or to sell access to those individual works within a collective work (all of which would be allowed by the *en banc* majority's test so long as they include a flip feature) will destroy the value of a freelancer's copyright. The amici highlight the practical problems inherent in such a flawed framework.

In response, Respondents insist that (1) freelancers are "at liberty" to compete with publishers to sell their works; (2) Mr. Greenberg had one post-CNG sale of his photographs that appeared previously in the National Geographic Magazine; and (3) the only "practicable" response to an adverse ruling in this case would be for publishers to "withdraw their archives from the market." (Br. in Opp. at 19-20).

The first two arguments, offered to show that no freelancer could possibly lose a "valuable right" under *Greenberg III*, fail under their own weight. The fact

that Mr. Greenberg made only a solitary post-CNG sale of his *National Geographic* photographs supports, rather than refutes, Mr. Greenberg's position. Moreover, Respondents do not dispute that publishers have no duty to even try to prevent unauthorized copying. At one point, the CNG actually encouraged users to appropriate the photographs for their own use. And even the last edition of the CNG made no effort to stop users from doing just that. Yet the *en banc* majority denies Mr. Greenberg, or any freelancer, any remedy or protection in such a situation.

The third argument fails because this Court has already rejected it:

> *Notwithstanding the dire predictions from some quarters* . . . [the publishers], and if necessary the courts and Congress, may draw on numerous models for distributing copyrighted works and remunerating authors for their distribution. . . . In any event, speculation about future harms is no basis for this Court to shrink authorial rights Congress established in § 201(c).

Tasini, 533 U.S. at 505-506 (emphasis in original). *Tasini* also recognized that many other countries with similar copyright laws as to freelancers have been able to come to reasonable resolutions on remuneration. *Id.* at 506 n.13.

The question is not whether archives will be available to the public in libraries (they have been for decades), but rather whether publishers will have to share some of their income from the new avenues of exploiting the secondary markets with freelancers. New ways of tapping the secondary markets emerge

every year. But by providing publishers an easily-met loophole to create a fictional "revision," the *en banc* majority's decision has, as a practical matter, excluded freelancers from benefiting from those future developments. This Court must halt the retreat from its decision in *Tasini*, and reaffirm congressional intent behind Section 201(c).

CONCLUSION

For all of the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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